

Application No. 09/827,933
Attorney's Docket No. 033768-002

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REMARKS

Applicant and Applicant's representative would like to thank Examiner Mohandesi for the courtesy extended during the telephone interview conducted on May 27, 2003. The arguments discussed during the telephone interview are summarized herein. Claims 1-3, 5, 6, 8-15, and 17-39 are currently pending.

Claim Objection

Claims 4, 7, and 16 have been objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 4, 7, and 16 have been canceled in the foregoing amendment.

Rejection Under 35 U.S.C. §102

Claims 8, 12, 16, 17, and 25-28 have been rejected under 35 U.S.C. §102(b) as being anticipated by Katz (4,279,415).

Claim 8 recites an article of footwear comprising a sole including an energy return system. The energy return system includes a first rigid plate and a second rigid plate spaced a predetermined distance from the first rigid plate. Two elastomeric separating elements are disposed therebetween to maintain the spacing between the plates. Claim 5 has been amended to recite that the separating elements allow independent movement of the first and second rigid plates with respect to one another in the medial lateral and vertical directions. As discussed in the telephone interview, the exercising device of Katz includes the hinge 14 between the base plate 10 and treadle plate 12. The hinge in Katz operates to prevent medial lateral or side-to-side movement between the plates in the same manner as a door hinge. Accordingly, Claim 8 and the claims depending therefrom, are allowable over Katz.

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Rejections Under 35 U.S.C. §103

Claims 1-12 and 14-32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jacinto (4,592,153). Jacinto describes a sole having a Z-shaped spring design (Z-Spring). As discussed in the telephone interview, the Z-Spring of Jacinto operates like a double cantilever and allows the three arms of the Z-shaped plate to move with respect to one another in the vertical direction while preventing motion in the lateral direction. Jacinto acknowledges this lack of side-to-side motion at column 2, lines 63-65 which describes the sole as "providing good stability to a user and inhibiting side-to-side motion."

To provide further evidence that the heel construction of Jacinto provides vertical motion without lateral motion between the plates, enclosed herewith is a Declaration of Ron Averill, a Ph.D. in Engineering Mechanics which states that the Z-Spring design of Jacinto exhibits negligible lateral deflection due to a direct lateral load. Also enclosed is a copy of Mr. Averill's report describing how he assessed the lateral deflection in the Z-Spring construction of Jacinto. The report describes that when a worst case scenario loading condition is considered and analyzed, a lateral deflection between the plates of less than 0.4 mm was calculated.

Thus, according to Jacinto himself and the declaration of a Ph.D. in Engineering Mechanics, the Z-Spring sole construction of Jacinto provides movement between the arms of the Z-shaped plate in the vertical direction but not in the medial lateral direction. Accordingly, Claims 1-12 and 14-32 are allowable over Jacinto.

Claims 2, 3, 9-11, 12, 13, and 15 have been rejected under 35 U.S.C. §103 as being unpatentable over Jacinto in view of Schmid (4,858,338). With respect to Claims 2, 3, and 9-11, the Schmid patent has been cited as a teaching of a particular material for the rigid plates. However, as discussed above, Jacinto does not teach or suggest first and second rigid plates which are movable with respect to one another in multiple dimensions as

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claimed. Schmid also does not teach relative lateral motion of two plates. Thus, the combination of Jacinto and Schmid does not teach or suggest the claimed invention.

Claim 12 recites in part that each of the first and second rigid plates extends substantially the entire length of a foot. There is no teaching or suggestion in the combination of Jacinto and Schmid that the individual arms of one of the Z-shaped resilient plates of Jacinto could be extended substantially the entire length of the foot. In contrast, Jacinto specifically requires multiple Z-shaped plates placed along the length of the foot. For this additional reason, Claim 12 is allowable.

Claim 15 recites that each of the first and second rigid plates extends from a toe area of the foot to an arch area of the foot. As illustrated in Jacinto the arms of the Z-shaped plates clearly do not extend all the way from the toe area of the foot to the arch area of the foot. Jacinto teaches that multiple Z-shaped plate systems are required to span the area of the toe, the area of the arch, and the area of the heel. For this additional reason, Claim 15 is clearly allowable over the combination of Jacinto and Schmid.

Summary

In summary, the shoe of the present invention stores up and returns energy during walking or running thereby improving the efficiency of the athlete. The energy return is provided by two spaced apart rigid plates separated by one or more elastomeric separating members which allow independent movement of the plates in the vertical and medial lateral directions. The ability to accommodate medial lateral motion allows the energy return system to receive and return energy throughout the gait cycle which is not limited to vertical motion. This configuration provides an improved energy return efficiency with less strain on the wearer than the shoes known in the prior art.

Since none of the prior art teaches or suggests first and second rigid plates and at least one separating element allowing independent movement of the first and second rigid plates with respect to one another in multiple dimensions including medial lateral movement and vertical movement, the claims are allowable over the prior art.

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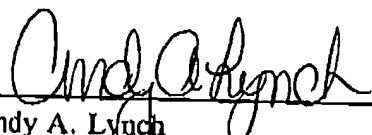
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New Claims 33-39 have been added which further define the protection to which Applicant is entitled.

In the event that there are any questions concerning this Amendment or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Cindy A. Lynch
Registration No. 38,699

P.O. Box 1404
Alexandria, Virginia 22313-1404
(650) 622-2300

Date: July 1, 2003

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- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.
- ☐ No additional claim fee is required.
- ☒ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims	36	MINUS 32 =	4	× \$18.00 (1202) =	72.00
Independent Claims	3	MINUS 3 =	0	× \$84.00 (1201) =	0
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					72.00
If small entity status is claimed, subtract 50% of Total Amendment Fee					36.00
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					\$36.00

☒ A claim fee in the amount of \$ 36.00 is enclosed.

☒ Charge \$ 36.00 to Deposit Account No. 02-4800.

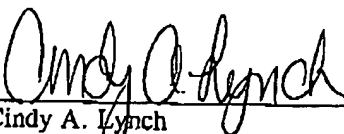
The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATIHS, L.L.P.

Date: July 1, 2003

By:


 Cindy A. Lynch
 Registration No. 38,699

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